

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MINORU TOH

Appeal No. 1997-3919
Application 08/392,160¹

HEARD: JANUARY 11, 2000

Before JERRY SMITH, FLEMING and FRAHM, ***Administrative Patent Judges***.

FLEMING, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision from the final rejection of claims 1 through 5, all the claims pending in the application.

The present invention relates to an observing apparatus to be used in a microscope. The only independent claims 1 and

¹Application for patent filed February 22, 1995.

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5 present in the application are reproduced as follows:

1. An apparatus for observing an object comprising:

an illuminating optical system for illuminating an object to be observed with visible light;

an observing optical system for observing the object positioned within a visual field illuminated by said illuminating optical system;

an index projecting optical system for projecting index for focus by luminous flux having wavelength of a visible area, the index projecting optical system having projecting luminous flux at least a part of which is common with a wavelength of illumination luminous flux of said illuminating optical system;

a first luminous flux restricting means for cutting an illuminating light of the illuminating optical system;

a second luminous flux restricting means for cutting a projecting light of the index projecting optical system;

means for controlling said first luminous flux restricting means and said second luminous flux restricting means so that the illuminating light and the projecting light do not overlap with each other on said object, and for controlling the period the illuminating light is off and the projecting light is on such that the projecting light is imperceptible as an after image to a normal human eye; and

means for detecting an image of focus index projected on said object, said means being capable of detecting luminous flux of visible wavelength;

wherein relative distance of said object with respect to the focus index is changed based on the results detected by said detecting means.

5. An apparatus for observing an object comprising:

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an illumination optical system for irradiating an
illumination light to an object to be observed;

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an observing optical system for observing the object with a reflection light of the illumination light irradiated to the object by said illumination optical system;

a focus index projecting optical system for projecting a light of focus index to the object to be observed;

means for restricting illumination luminous flux by intermittently shutting said illumination light, which is provided in said illumination optical system;

means for restricting luminous flux of focus index by intermittently shutting said focus index light, which is provided in said focus index projecting optical system; and

means for detecting focus distance and direction by synthesizing synchronous timing signals of said illumination luminous flux restricting means and said focus index luminous flux restricting means, wherein the position of the object to be observed is changed based on the signal detected by said focus detecting means.

The references relied on by the Examiner are:

Salzmann	5,270,527	Dec. 14,
1993		

Kinoshita	02-300707	Dec.
12, 1990		
(Japanese Published Application)		

The specification is objected to under 35 U.S.C. § 112, first paragraph, because the specification, as originally filed, does not provide support for the invention as is now claimed. Claims 1 through 4 stand rejected under 35 U.S.C. §

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112, first paragraph for the reasons that the specification is objected to. Claims 1 through 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kinoshita and Salzmann.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the brief and answer for the details thereof.

OPINION

After a careful review of the evidence before us, we agree with the Examiner that claim 5 is properly rejected under 35 U.S.C. § 103. Thus, we will sustain the rejection of claim 5 but we will reverse the rejection of claims 1 through 4 for the reasons set forth *infra*.

In regard to the rejection of claims 1 through 4 under 35 U.S.C. § 112, first paragraph, the Examiner argues that the specification does not have support for luminous flux having wavelength of a visible area. On pages 7 and 8 of the brief, Appellant makes reference to page 5, lines 5 through 7, of the specification that states that the light source 1 may comprise "a halogen lamp which emits white light." Appellant argues that one of ordinary skill in the art would readily recognize that a halogen lamp would emit luminous flux having a wavelength of a visible area as set forth in Appellant's claims.

"The function of the description requirement [of the first paragraph of 35 U.S.C. 112] is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him." ***In re Wertheim***, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). "It is not necessary that the application describe the claim limitations exactly, . . . but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented the processes including those limitations." ***Wertheim***, 541 F.2d at 262, 191 USPQ at 96 citing ***In re Smythe***, 480 F.2d 1376, 1382, 178 USPQ 279, 284 (CCPA 1973). Furthermore, the Federal Circuit points out that "[i]t is not necessary that the claimed subject matter be described identically, but the disclosure originally filed must convey to those skilled in the art that applicant had invented the subject matter later claimed." ***In re Wilder***, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984), ***cert. denied***, 469 U.S. 1209 (1985), ***citing In re Kaslow***, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

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Upon our review of the specification, we find that the application does not use the exact words "luminous flux having wavelength of a visible area." However, 35 U.S.C. § 112 does not require that the Applicant use the exact words in the specification that are set forth in the claimed limitations. Instead, 35 U.S.C. § 112 only requires that it is necessary that the application describe the claimed limitations so that one of ordinary skill in the art would have recognized from the disclosure that Appellant did indeed possess the claimed invention. Upon reviewing the claim language as recited in Appellant's claim 1, we find that the disclosure as originally filed would have conveyed to those skilled in the art that Appellant had invented the subject matter now claimed. Therefore, we will not sustain the Examiner's rejection of claims 1 through 4 under 35 U.S.C. § 112, first paragraph.

In regard to the rejection of claims 1 through 4 under 35 U.S.C. § 103, we fail to find that the Examiner has set forth a ***prima facie*** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have

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been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983).

"Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), ***cert. denied***, 519 U.S. 822 (1996), ***citing W.L. Gore & Assocs., Inc. v. Garlock, Inc.***, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), ***cert. denied***, 469 U.S. 851 (1984).

On page 12 of the brief, Appellant argues that neither Kinoshita nor Salzmann teach or suggest an index projecting optical system for projecting index for focus by luminous flux having wavelength of a visible area, the luminous index projecting optical system having projecting luminous flux at least a part of which is common with the wavelength of luminous flux of said illuminating optical system as required by claim 1.

Appellant points out that Kinoshita and Salzmann disclosed using IR light source 10 and not a light source that would provide a wavelength of visible area.

Upon our review of Kinoshita and Salzmann, we find that neither reference teaches "an index projecting optical system for projecting index for focus by luminous flux having wavelength of a visible area, the index projecting optical system having projecting luminous flux at least a part of which is common with a wavelength of illumination luminous flux of said illuminating optical system" as recited in Appellant's claim 1. We note that neither Kinoshita nor Salzmann teach an index projecting optical system for projecting index for focus by a luminous flux having wavelength of a visible area.

Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Kinoshita and Salzmann. On page 12 of the appeal brief, Appellant argues that Salzmann does not teach an index projecting optical system to be used to project an index for focus.

As pointed out by our reviewing court, we must first

determine the scope of the claim. "[T]he name of the game is the claim." ***In re Hiniker Co.***, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Claims will be given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. ***In re Etter***, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985).

We note that unlike the Appellant's claim 1, Appellant's claim 5 is not limited to an index projecting optical system for projecting index for focus by luminous flux having wavelength of a visible area. In contrast, Appellant's claim 5 recites "a focus index projecting optical system for projecting a light of focus index to the object to be observed."

Appellant argues that Salzmann does not teach a focus index projecting optical system for projecting a light of focus index to the object to be observed. We note that the Examiner's rejection does not rely on Salzmann for this limitation. In contrast, the Examiner relies on Kinoshita for the limitation of a focus index projecting optical system for

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projecting a light of focus index to the object to be observed.

Upon our review of Kinoshita, we find that Kinoshita teaches on page 4, a pattern projecting optics 4 for projecting a light of focus index to the object to be observed. Therefore, we find that Kinoshita's pattern projection optics 4 meet Appellant's claimed focus index projecting optic system as recited in Appellant's claim 5. Therefore, we find that the Appellant has not shown that the Examiner has erred in making this rejection in regard to Appellant's claim 5.

We note that Appellant has chosen not to argue any of the other specific limitations of claim 5 as a basis for patentability. As stated by our reviewing court in ***In re Baxter Travenol Labs.***, 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991), "[i]t is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art." 37 C.F.R. § 1.192(a)(July 1, 1996) **as amended at** 60 Fed. Reg. 14518 (March 17, 1995), which was controlling at the

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time of Appellants filing the brief, states as follows:

The brief . . . must set forth the authorities and arguments on which the appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief may be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

Also, 37 C.F.R. § 1.192(c)(8)(iv) states:

For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.

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Thus, 37 C.F.R. § 1.192 provides that this board is not under any greater burden than the court which is not under any burden to raise and/or consider such issues. Therefore, we are not required to raise and/or consider such issues.

In view of the foregoing, the decision of the Examiner rejecting claim 5 under 35 U.S.C. § 103 is affirmed; however, the decision of the Examiner rejecting claims 1 through 4 under 35 U.S.C. § 103 is reversed. In addition, the decision of the Examiner rejecting claims 1 through 4 under 35 U.S.C. § 112, first paragraph, is reversed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 C.F.R.
§ 1.136(a).

AFFIRMED-IN-PART

JERRY SMITH)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
MICHAEL R. FLEMING)	
Administrative Patent Judge)	APPEALS AND
)	
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